

REMARKS

Presently, claims 25-39 are pending in the application.

Prior Art Rejection – 35 U.S.C. § 102(b)

The Examiner has rejected claims 25-39 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,029,045 to Picco *et al.* (“Picco”). The Examiner contends that Picco teaches all elements of these claims. Applicants respectfully traverse this rejection.

Picco teaches a system and method for providing targeted content, including advertisements, to specified groups of television viewers. To aid in allocating advertisements to different groups of viewers, Picco collects data regarding viewer use. Specifically, Picco discloses:

[D]ata about the local content being watched at a particular household may be periodically communicated to the collect and decimate system in the uplink facility over a communications link such as a telephone line. The data from the household may include viewing time information as well as the actual television programs being viewed.
(column 7, lines 12-18) (emphasis added)

In Picco, the viewer data is “accumulated” by a set-top box and transmitted “to the system operator at some predetermined interval” (column 10, lines 52-58 and column 11, lines 9-12). Picco also describes the set-top box as operating, even when it is “probably not being used for viewing television” (column 9, lines 25-27). Thus, although Picco collects data regarding what programming was selected on a set-top box, Picco’s system is not aware of, and therefore does not examine or otherwise collect data from, the state of the presentation device (e.g., the television set, display panel or monitor) that actually presents the video image to the viewer.

Applicants’ invention inserts unscheduled advertisements into a television programming stream for presentation to a subscriber. Once an advertisement is inserted, a determination is made as to whether the advertisements were actually presented to the individual subscribers. This is accomplished by “monitoring the communications network to determine, based on the state of the presentation device, whether the selected

unscheduled advertisements are presented to each of the one or more subscribers.” In other words, Applicants’ invention determines, for example, whether the television or video monitor was powered on at the time of the advertisement.

For a rejection under 35 U.S.C. §102(b) to be proper, a reference must disclose, either explicitly or inherently, each and every element of the claimed invention. Applicants respectfully submit that Picco does not disclose each and every element recited in independent claim 25.

Independent claim 25 recites:

A method of inserting unscheduled advertisements into a television programming stream in a communications network, the method comprising:

- (a) selecting one or more unscheduled advertisements to be presented to one or more subscribers to the communications network;
- (b) storing the unscheduled advertisements at a node of the communications network;
- (c) detecting intervals in said programming stream within which advertisements may be inserted;
- (d) inserting the unscheduled advertisements into said programming stream within the detected intervals; and
- (e) monitoring the communications network to determine, based on the state of the presentation device, whether the selected unscheduled advertisements are presented to each of the one or more subscribers.

Picco does not disclose that the state of the presentation device is monitored.

Applicants respectfully, but strenuously, disagree with the Examiner’s statement that “It is *inherent* that data about local content being watched at a particular household *is based on the state of the presentation device.*” Applicants respectfully submit that the Examiner is incorrect in the example provided at page 2 of the Office Action, wherein the Examiner argues “if the state of the presentation device is non-operational, data is not going to be collected.” On the contrary, it is quite possible that a set-top box could be on while its corresponding presentation device is off. Picco actually suggests such a

possibility, in disclosing that the set-top box, through which viewing data is collected, can be operational even “while the set-top box is probably not being used for viewing television” (see column 9, lines 25-28 of Picco). Therefore, in Picco, the television or video monitor can be off while the set-top box is on. Thus, Picco’s system is completely unaware of the state (e.g., on or off) of the television (*i.e.*, the presentation device) connected to the set-top box. As such, Picco does not disclose determining anything “based on the state of the presentation device,” as recited in independent claim 25. Accordingly, Picco employs a different analysis in determining what programming and/or advertisements are seen by a viewer. That is, in claim 25, because the state of the presentation device is used to make the viewership determination, Applicants’ invention is able to utilize different information and analysis to produce a different result than disclosed in Picco, where the analysis is based on information collected from the data content of the set-top box. Since the presentation device could be off while the set-top box is on, how and from where the data is obtained, is significant to the analysis and results.

Additionally, Picco does not disclose “monitoring the communications network” as recited in claim 25. Picco discloses that data about the user profile is generated by the set-top box and transmitted to the system operator “at some predetermined interval” (column 10, line 58). However, passive reception of user profile data at predetermined intervals is not “monitoring” the network. That is, at best, Picco’s system transmits data from the set-top box at scheduled time(s) that are designated for transmission of the viewer profile data and corresponding reception of that data by the collect and decimate system 152 or the system operator. In Picco, the viewer profile data is only accessible by the system operator when such data is transmitted from the set-top box. Stated differently, Picco does not disclose that the system operator can actively request viewer profile information from a set-top box. In contrast, in independent claim 25, “monitoring the communications network” permits the state of the presentation device (or any other desired information) to be obtained according to the control of a headend or operator – not according to the schedule or control of the set-top box. Accordingly, Picco does not disclose all of the elements recited in independent claim 25.

Similarly, independent claim 30, recites “a monitor processor configured to monitor the communications network to determine, based on the state of the presentation device, whether the selected unscheduled advertisements are presented to each of the one or more subscribers.” Independent claim 35 recites “monitoring the communications network to determine, based on the state of the presentation device, whether the selected unscheduled advertisements are presented to each of the one or more subscribers.” For the same reasons discussed above with respect to independent claim 25, Picco does not disclose all of the features of independent claims 30 and 35.

Claims 26-29, 30-34 and 36-39 are allowable at least by their dependency on independent claims 25, 30 and 35 respectively. Reconsideration and withdrawal of the Examiner's rejection of claims 25-39 are respectfully requested.

Conclusion

In view of the foregoing remarks, Applicants respectfully submit that the Examiner's rejection has been overcome, and that the application, including claims 25-39 is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejection and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

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